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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/590,850

08/25/2006

Kazuhiko Fujisawa

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EXAMINER

VALENROD, YEVGENY

ART UNIT

PAPER NUMBER

1621

MAIL DATE

DELIVERY MODE

02/25/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/590,850	Applicant(s) FUJISAWA ET AL.	
	Examiner YEVEGENY VALENROD	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 3-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following is a non-final rejection in application # 10/590,850. This application has been reassigned to examiner Valenrod whose contact information is provided at the end of the instant document.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/12/08 has been entered.

Amendment to the claims filed 9/12/08 is acknowledged.

Rejection of claims 1-2 and 7-10 under 35 USC 112 2nd paragraph is withdrawn in view of applicants' amendment and remarks.

Rejection of claims 1-2 and 7-10 under 35 USC 112 1st paragraph is withdrawn in view of applicants' amendment and remarks.

Rejection of claim 1 under 35 USC 102(b) over Nakamura et al. is withdrawn in view of applicants amendment in favor of a modified rejection over the same reference.

Rejection of claims 1-2 and 7-10 under 35 USC 103(a) over Nakamura in view of Inoue et al. is withdrawn in view of applicants amendments in favor of a modified rejection over the same references.

Claim Rejections – 35 USC 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

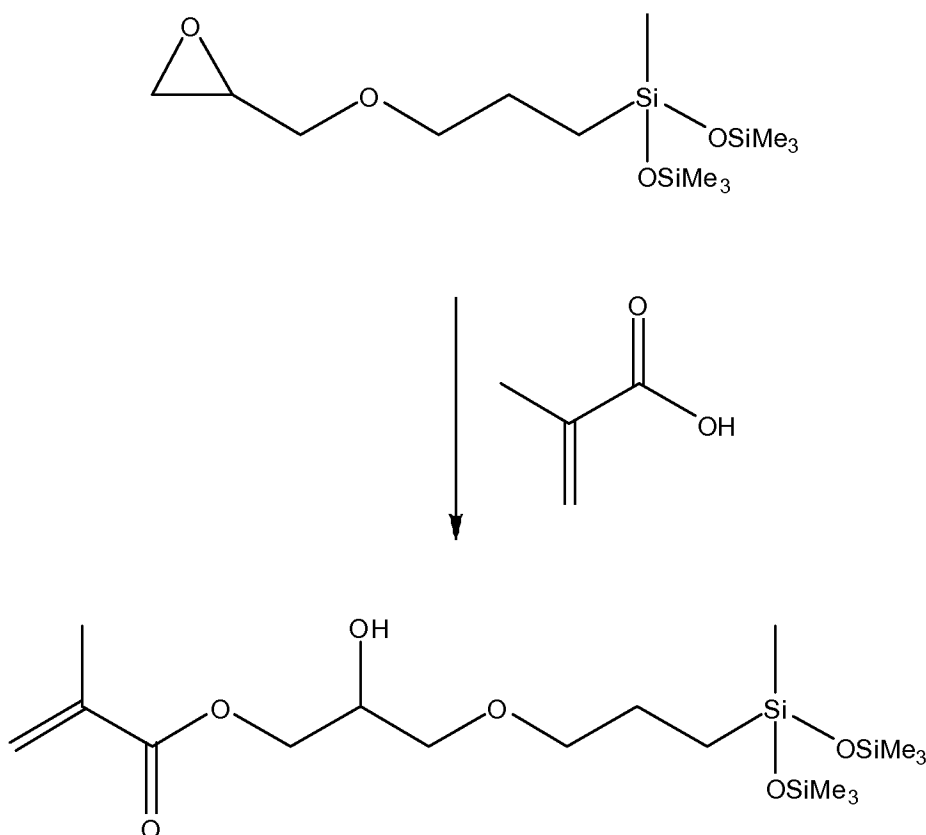
Claim 1 and 7-10 is rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura et al. (US 2004/0198916).

The instant claims are drawn to a process for producing a silicone compound by reacting a metal salt of the carboxylic acid with an epoxy silane, in the presence of 0.3 wt % or more of water.

Nakamura et al. teaches a process in which the metal salt of the carboxylic acid is formed in situ, by the addition of potassium hydroxide. The potassium salt of the acid reacts with the epoxy silane derivative to give the silicone product as shown below

Art Unit: 1621

(page 6, section 67). In addition, ACS reagent grade potassium hydroxide contains 10-15% water, see printout¹.



Limitation directed to 0.3 wt% of water being present in the reaction system is inherently met by the process described by Nakamura. Nakamura describes adding potassium hydroxide to methacrylic acid (see paragraph [0067], lines 1-8). Immediate product of potassium hydroxide and methacrylic acid being brought into contact is water and potassium methacrylate. There is therefore a 1 mole equivalent of water being

¹ Sigma-Aldrich specification sheet for potassium hydroxide, ACS reagent grade.

Art Unit: 1621

formed in addition to the water already present in potassium hydroxide. The net amount of water in the reaction is therefore more than 0.3 wt%.

Although Nakamura fails to describe the purity of the formed product, this limitation is inherently met. Since the method by which Nakamura obtains the product is the same as the instantly claimed method, it stands to reason that the product is of the same purity as in the instant claims.

Claim Rejections - 35 USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al. (US 2004/0198916), in view of Inoue et al. (US 5,891,356).

The instant claims have been previously described.

Art Unit: 1621

The teaching of Nakamura et al. has also been previously described.

Nakamura et al. is deficient in that it does not explicitly state that the silicone product was purified by silica gel column chromatography and is silent as to the purity of the product.

Inoue et al. teaches the purification of a silicone compound by silica gel column chromatography (column 11, lines 48-49; column 14, lines 50-51).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time of the invention, to use Inoue et al.'s purification method using silica gel column chromatography for Nakamura et al.'s process of making silicone compounds. One of ordinary skill in the art would be motivated to use column chromatography as a purification method with the reasonable expectation that the yield and purity of the product would increase. Absent any showing of unusual and/or unexpected results over applicant's particular purification method, the art obtains the same effect on the purity and yield of the silicone compounds. Furthermore, the limitations in some of the dependent claims, not expressly taught in the art, are also deemed to be obvious. One of ordinary skill in the art would be motivated to make fine adjustments and optimize these parameters to arrive at the instantly claimed invention. The expected result would be the efficient production of silicone compounds for the ophthalmic lens industry.

Reply to applicants' remarks

Art Unit: 1621

Applicants' remarks have been carefully considered. Examiner believes that the arguments presented in the remarks have been sufficiently addressed in the above art-based rejections.

Conclusion

Claims 1-10 are pending

Claims 1-2 and 7-10 are rejected

Claims 3-6 are withdrawn

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yevgeny Valenrod whose telephone number is 571-272-9049. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yevgeny Valenrod/

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